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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,473	11/19/2001	Rick A. Ziebell	53511-5002	5163

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11

EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 05/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/997,473

Applicant(s)

ZIEBELL, RICK A.

Examiner

Marc S. Zimmer

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14, 17, 18, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17 and 18 is/are allowed.
- 6) ☒ Claim(s) 25 and 26 is/are rejected.
- 7) ☒ Claim(s) 14, 25 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Subsequent to a telephone interview between the Examiner and Applicant conducted on April 30, 2003, the Applicant submitted for consideration an amendment that addressed issues raised during the interview regarding claims 25 and 26. However, the Applicant has failed to address the Examiner's concerns about the apparent characterization of vinyltrimethoxysilane, chlorotrimethoxysilane, and divinyl dimethoxysilane as variants of an epoxy-functional compound on page 11 of the Specification. Applicant was reminded during the interview that this same problem was pointed out in the parent case. To reiterate, Applicant may clarify the record with the same explanation that was provided during the prosecution of that case.

Because Applicant did not satisfy all of the Examiner's concerns with their submission received in the Office on May 16, 2003, it is not possible to allow the case at this time. To expedite prosecution, the Examiner thoroughly reviewed the case to ensure that there were no other issues remaining that escaped notice previously. It was determined that claims 25 and 26 should have been rejected for the reason cited *infra*. Other minor issues relating to the formulaic representation of the epoxy compound and the claim language of claim 25 are also delineated herein.

Specification

The representation of the epoxy-functional compound is still not correct. While the formula now reflects the presence of an epoxy (glycidoxy) group, the formula is not supported by the original disclosure. The only epoxy-functional silane identified in the original disclosure is glycidoxypropyltrimethoxysilane. The formula incorporated into the

amendment dated March 7, 2003 does not adequately represent that compound as the propyl and glycidoxy moieties are part of the same radical as,



Furthermore, the amendment to the Specification now states that the hydrolyzable groups may include ketoximo- and carboxy radicals. However, only alkoxy groups are supported by the original disclosure.

Claim Objections

Claim 14 is objected to because it is believed that component (D) should be referred to as ethyl-cyclohexen-1-ol. The Examiner is not familiar with the utilization of fully saturated alcohols as a hydrosilylation reaction inhibitor.

Claims 25 and 26 are objected to because it is not sufficiently clear that the resin is the substrate to which the organopolysiloxane composition shows selective adhesion. (As the Examiner understands the instant invention, the composition was developed so that composites of a polysiloxane and an organic resin could be formed in a mold without the silicone component sticking to the walls of the mold. By stating that the organopolysiloxane composition exhibits selective adhesion to a substrate when a resin has already been recited, it appears that the resin and substrate are different components. In the context of Applicant's full disclosure, it is the Examiner's belief that the silicone is bound selectively to the resin. Therefore, claim 25 should be amended to state that the composition has selective adhesion towards the resin and remove mention of a substrate.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17 and 18 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no antecedent basis earlier in claim 17 for a "polymer system". It is the organopolysiloxane composition that contains the components recited therein hence "polymer system" should be replaced with "composition".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Murumatsu et al., U.S. Patent # 5,879,809. At second glance there is little differentiating claim 25 from original claim 1 other than the composition is in intimate contact with a resin of undefined constitution and the amount of the epoxy-functional compound is specified. The abstract of the reference clearly states that the silicone rubber component is bonded to a thermoplastic resin hence the first requirement is satisfied. The reference further states that the epoxy-functional compound, which also

Art Unit: 1712

fulfills the stated necessity for an adhesion promoter, is made available as 0.1 to 50 parts relative to 100 parts of the base resin.

Amended claim 26 mirrors original claim 3 (with the caveat that the formula and, thus, some of the variables have been corrected), which had been previously rejected in view of the teachings at column 8, lines 16-26.

Allowable Subject Matter

Claim 14 is allowable over the prior art because none of the references disclose this particular catalyst inhibitor nor is there an incentive provided by the art to replace the various inhibitors contemplated in the previously applied references with this additive. Claims 17-18 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action. because the references do not consider contacting the instant invention with the particular article recited in the claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 703-605-1176. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Application/Control Number: 09/997,473

Page 6

Art Unit: 1712

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

May 21, 2003

A handwritten signature in black ink, reading "Robert A. Dawson". The signature is fluid and cursive, with a long horizontal stroke at the end.

Robert Dawson
Supervisory Patent Examiner
Technology Center 1700